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08/113,329 08/30/93 HARVEY

J 56348

HARVEY, D EXAMINER

26M1/0823

ART UNIT PAPER NUMBER

13

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2602

DATE MAILED: 08/23/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 5/11/95 This action is made final.

A shortened statutory period for response to this action is set to expire 3 (three) month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1. Claims 1-3, 5, 7-11, 13, 16-20, 22, 23, 31-40, 42, 44, 49-84 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 1-3, 5, 7-11, 13, 16-20, 22, 23, 31-40, 42, 44, 49-84 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

1. Claims 1-3, 5, 7-11, 13, 16-20, 22, 23, 31-40, 42, 44, and 49-84 are rejected under the judicially created doctrine of double patenting in view of claims 1-13 of U.S. Patent No. 4,694,490 for the reasons set forth in paragraph 2 of paper #10. Basis for the rejection can be found in the case-law cited in paragraph 1 of paper #10 [ie in particular, note **In re Schneller**, 158 USPQ 210 (CCPA 1968)].

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same

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person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

4. Claims 1 and 82/1 are rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over **Lambert '522**.

Lambert discloses a system for controlling an intermediate television transmission station as is shown in figure 1. The system comprises:

- a) a receiving unit (26) for receiving a unit of television programming from a remote television programming source [see lines 37-40 of column 2];
- b) means (ie 22) for inputting to a computer (11) a programming schedule designating for said unit of programming a predetermined configuration for switch 14, transmitter 14, and combiner 16 [see lines 22-30 and 34-48 of column 2]; and
- c) communicating means (17) for communicating said unit from the station (11-16, 24, 25, and 26) to subscriber locations (18).

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Although not explicitly stated, it is maintained that it would at least have been obvious to one skilled in the art that the program schedule contained in the computer (11), and transmitted to the subscribers @ line 13, includes/designates the output channel to be used to communicate the unit of programming [see lines 45-48 of column 2].

5. Claims 2-3, 5, 7-11, 13, 16-20, 22, 23, 31-40, 42, 44, and 49-81, 83, and 84 avoid the art of record.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Harvey whose telephone number is (703) 305-4365.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

DEH 7/24/95

David E. Harvey
Examiner
Group 2602